

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on May 3, 2005. Claims 1-10 are pending in the Application and Claims 1-8 stand rejected. Claims 1-8 are amended and new Claims 9 and 10 are added by the present Amendment.

In the outstanding Office Action, the specification, the drawings, and Claims 1-8 were objected to; and Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi et al. (U.S. Patent No. 6,237,577, hereinafter "Takahashi").

Applicants thank Examiner Marguerite J. McMahon for the courtesy of an interview extended to Applicants' representative on May 24, 2005. During the interview, amendments to the claims as herein presented were proposed, and arguments as hereinafter developed were presented.

During the interview, Applicants' representative explained the instant invention and many of its advantageous features, including, but not limited to, an improved gas-liquid separating performance of a blowby mixture of a breather device formed in an inner side of a breather chamber with a labyrinth structure.¹

In addition, it was explained that Takahashi cannot support a *prima facie* case of obviousness of the inventions in this application because the breather chamber of the instant invention comprises a portion of the crankcase. As clearly shown in FIG. 1 of Takahashi, "the breather chamber 30 is provided in the upper part of the cylinder head cover 4, between the cylinder head cover 4 and the cam holder 31."²

Although an agreement with respect to the claims was not reached during the personal interview, Examiner McMahon indicated on the interview summary (form PTO 413) that

¹ See, for example, Specification, pages 1 and 2.

² Takahashi, col. 2, lines 36-38.

“[t]he attorney explained the invention to the Examiner, and the Examiner made suggestions as to the need for a clear showing of the invention in the drawings and clarification of claim language. The claims recited the cam chamber being located above the breather clamber, but the drawings appeared to show otherwise.”

As to the objection of Applicants' specification, Applicants note with appreciation the time taken by the Examiner to identify the need for revisions. Applicants have herein submitted replacement to several paragraphs in the specification to correct several informalities and respectfully request reconsideration of the same.

Applicants respectfully submit that the suggestion for the submission of a new figure has been obviated by the instant amendments to the claims. A non-limiting example of the structural features claimed in the presently amended Claims 1 and 5 is shown in FIG. 13 of Applicants' specification. As to the statement that element 71D has been used to designate both a front rib and a front rib, Applicants respectfully disagree. As clearly explained in Applicants' specification, see, for example, the last paragraph on page 31, and FIGS. 10, 12, and 13, element 71D refers to the front rib. As such, reconsideration to the objection of Applicants' drawings under 37 C.F.R. § 1.84(p)(4) is respectfully requested.

Claim 1-8 were objected to because of several informalities. Applicants note with appreciation the time taken by the Examiner to identify needed revisions. Applicants have amended Claims 1-8, including correction of the cited informalities, and respectfully request reconsideration of the objection thereto. In addition, in view of the present amendment, it is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

As to the rejection of Claims 1-8, Applicants respectfully submit that Takahashi does not support a *prima facie* case of obviousness of the invention recited in the presently amended Claims 1 and 5. This is so because this reference does not teach or suggest all the claimed features.

According to a feature of the invention as set forth in Claim 1, a breather device is recited, comprising, among other features, a first portion disposed in the crankcase of the engine and a second portion disposed in a first case. As explained during the personal interview and summarized hereinabove, in Takahashi, as illustrated in FIG. 1 of that reference, “the breather chamber 30 is provided in the upper part of the cylinder head cover 4, between the cylinder head cover 4 and the cam holder 31.” As such, the breather chamber 30 does not comprise a first portion disposed in the crankcase 1 of the disclosed engine.

Therefore, Takahashi does not make obvious the invention recited in the presently amended Claim 1. In addition, Claims 2-4 should be allowed, among other reasons, as depending either directly or indirectly from Claim 1, which should be allowed as just explained. For the foregoing remarks, Applicants respectfully request withdrawal of the rejection of Claims 1-4 under 35 U.S.C. § 103(a).

Claim 5 now recites a breather device comprising means for separating an oil and a gas in a blowby mixture entering the breather device. Applicants respectfully submit that under the provisions of 35 U.S.C. § 112, sixth paragraph³ and the examining guidelines clearly outlined in the MPEP § 2181-2183, Claim 5 is neither anticipated nor made obvious by Takahashi because (1) the breather device disclosed therein does not perform an identical function substantially the same way to produce substantially the same results as the breather

³ “The broadest reasonable interpretation that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” MPEP § 2181, citing *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

device of the present invention;⁴ (2) those of ordinary skill in the art would not recognize the interchangeability of the elements of Takahashi to the ones disclosed in Applicants' specification;⁵ (3) the differences between the elements in Takahashi and corresponding elements disclosed in Applicants' specification are substantial;⁶ or (4) the elements in Takahashi are not structural equivalents of the corresponding elements disclosed in Applicants' specification.⁷ As such, Applicants respectfully submit that Claim 5 patently distinguishes over Takahashi. Claims 6-8 depend from Claim 5. Therefore, withdrawal of the outstanding rejection of Claims 5-8 based on Takahashi is respectfully requested.

Finally, Applicants have submitted new Claims 9 and 10, which find non-limiting support on the subject matter originally recited in Claims 1 and 5. Therefore, new Claims 9 and 10 are not believed to raise a question of new matter.⁸ Because Claims 9 and 10 incorporate by reference all of the features of Claim 1 or Claim 5, respectively, in view of the

⁴ A showing that "the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification" would be sufficient to support a conclusion that elements in the cited reference would be equivalents to the recited elements. See, for example, MPEP § 2183, citing *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000).

⁵ A showing that "a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification" would be sufficient to support a conclusion that elements in the cited reference would be equivalents to the recited elements. See, for example, MPEP § 2183, citing *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 56 USPQ2d 1305 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus. Inc.*, 145 F.3d 1303, 1309, 46 USPQ2d 1752, 1757 (Fed. Cir. 1998); *Lockheed Aircraft Corp. v. United States*, 193 USPQ 449, 461 (Ct. Cl. 1977); and *Data Line Corp. v. Micro Technologies, Inc.*, 813 F.2d 1196, 1 USPQ2d 2052 (Fed. Cir. 1987).

⁶ A showing that "there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification" would be sufficient to support a conclusion that elements in the cited reference would be equivalents to the recited elements. See, for example, MPEP § 2183, citing *IMS Technology, Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138 (Fed. Cir. 2000); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 117 S. Ct. 1040, 41 USPQ2d 1865, 1875 (1997); *Valmont Industries, Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 25 USPQ2d 1451 (Fed. Cir. 1993); and *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 56 USPQ2d 1305 (Fed. Cir. 2000).

⁷ A showing that "the prior art element is a structural equivalent of the corresponding element disclosed in the specification" would be sufficient to support a conclusion that elements in the cited reference would be equivalents to the recited elements. See, for example, MPEP § 2183, citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

⁸ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

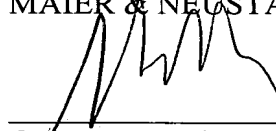
above-presented remarks, Applicants respectfully submit that new Claims 9 and 10 should be allowed over Takahashi.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-10 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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